

D3 14
27. (Amended) A mammalian cell [harboring with] which harbors the synthetic gene of claim 1.

D3 18
28. (Amended) A method for preparing a synthetic gene encoding a protein normally expressed by mammalian cells, comprising identifying non-preferred and less-preferred codons in the natural gene encoding said protein and replacing one or more of said non-preferred and less-preferred codons with a preferred codon encoding the same amino acid as the replaced codon, so that a synthetic gene is prepared.

REMARKS

Summary of Office Action

Claims 1-10, 17-20, and 25-28 are pending in this application.

Claims 1-10, 17-20, and 25-28 stand rejected, under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1-10, 17-20, and 25-28 also stand rejected, under 35 U.S.C. § 102(a), as being anticipated by Seed (WO 96/09378) and, under 35 U.S.C. § 102(e), as being anticipated by Seed (U.S. Pat. No. 5,786,464).

Election/Restriction

Applicant affirms the election made without traverse to prosecute species claims

17, 18, and 20, as well as generic claims 1-10, 19, and 25-28. Accordingly, claims 11-16 and 21-24 have been canceled as being drawn to a non-elected invention.

Formal Drawings

Applicant notes that formal drawings are required and agrees to submit such drawings upon indication of allowable subject matter.

Rejections under 35 U.S.C. § 112, second paragraph

Claims 1-10, 17-20, and 25-28 stand rejected, under 35 U.S.C. § 112, second paragraph, as being indefinite on a number of separate grounds, which are addressed as follows.

Claim 1 was deemed indefinite in the recitation of the phrase “being capable of expressing.” This rejection has been met by the deletion of this phrase from claim 1.

Claims 2-4 were deemed indefinite in the recitation of the phrase “is capable of expressing.” This rejection has been met by changing the phrase “is capable of expressing” to “expresses.”

Claim 18 was deemed indefinite for having no clear antecedent basis for the phrase “said human protein.” This rejection has been met by the amendment of claim 18 to depend from claim 17 instead of claim 1.

Claim 27 was deemed indefinite in the recitation of the phrase “harboring with.” This rejection has been met by changing the phrase “harboring with” to “which harbors.”

And claim 28 was deemed indefinite for failing to recite the phrase “so that a synthetic gene is prepared.” This rejection has been met by the insertion of this phrase after “codon” on line 7 of claim 28.

In view of these amendments, the rejections under § 112, second paragraph, may be withdrawn.

Rejection under 35 U.S.C. § 102(a)

Claims 1-10, 17-20, and 25-28 stand rejected, under 35 U.S.C. § 102(a), as being anticipated by Seed (WO 96/09378). This rejection is respectfully traversed. The cited reference, WO 96/09378, was published on March 28, 1996, a date which is less than one year before the September 20, 1996 filing date of the present application. In addition, Brian Seed, the sole author of the WO 96/09378 publication, is also an inventor of the present application. As stated in section 2132.01 of the M.P.E.P.:

[A]pplicant’s disclosure of his or her own work within the year before the application filing date cannot be used against him or her under 35 U.S.C. 102(a).

In view of the above, this rejection may be withdrawn.

Rejection under 35 U.S.C. § 102(e)

Claims 1-10, 17-20, and 25-28 stand rejected, under 35 U.S.C. § 102(e), as being anticipated by Seed (U.S. Pat. No. 5,786,464). This rejection is also respectfully traversed.

Applicant notes that a Petition to Correct Inventorship was recently filed with the United States Patent and Trademark Office, on October 20, 1998, changing the inventorship of Seed (U.S. Pat. No. 5,786,464) from Brian Seed alone to Brian Seed and Jurgen Haas. As a result of this change, the inventors of U.S. Pat. No. 5,786,464 are now identical to the inventors of the above-referenced application. Accordingly, under 35 U.S.C. § 102(e), Seed (U.S. Pat. No. 5,786,464) does not constitute prior art to the present invention, and this rejection may also be withdrawn.

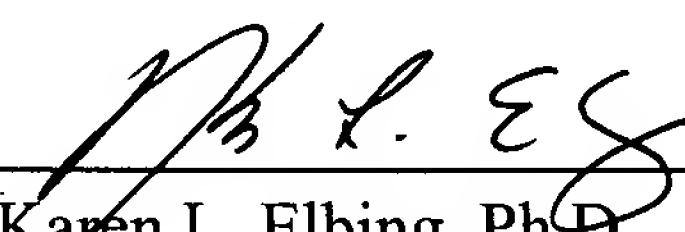
CONCLUSION

In view of the amendments and remarks set forth above, applicants submit that this application is now in condition for allowance, and such action is respectfully requested.

If there are any charges, or any credits, please apply them to Deposit Account No. 03-2095.

Respectfully submitted,

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